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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,092	02/10/2006	Sang-Kee Kim	0172-P0105A	7766

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HYUN JONG PARK  
Park & Associates IP Law LLC  
265 Bic Drive  
Suite 106  
Milford, CT 06461

EXAMINER
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WALKER, NED ANDREW

ART UNIT	PAPER NUMBER
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3788

MAIL DATE	DELIVERY MODE
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12/21/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,092	<b>Applicant(s)</b> KIM, SANG-KEE	
	<b>Examiner</b> NED A. WALKER	<b>Art Unit</b> 3788	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 3,5 and 18-20 is/are pending in the application.
- 5a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 3 and 5 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Newly added Claims 18-20 are directed to an alleged invention that is independent or distinct from the alleged invention in original Claim(s) 1-8 for the following reasons: the newly added claim(s) are directed to a new category of invention that was not previously claimed. Specifically, the claims are drawn to a combination of a container and cover and a previously unclaimed combination constitutes a new category of invention. The original presentation of independent Claim(s) 1-8 was simply directed to the subcombination of “a container cover.”

There is now an additional examination and search burden for the newly presented category of invention. Searching a combination for the particular container and container-closure configuration, function, and relationships requires a new classification and keyword search that is independent and/or distinct from previous searches focused on the container cover.

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 18-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The resulting claim status is Claims 3 and 5 are pending, wherein Claims 1, 2, 4, and 6-17 have been cancelled and Claims 18-20 have been withdrawn.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**4. Claims 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by McMann (US Pat. No. 1,857,853).**

McMann discloses a container cover (FIGS. 1-2) comprising: a cover plate (19) having a front surface and a rear surface (lower surface of 19 in FIG. 2), the cover plate for covering an opening of a container; and a closing member (17, 18) having two fixing portions (20, 21), a first fixing portion (21) fixed to the cover plate along a peripheral portion of said rear surface of said cover plate (FIG. 2) and a second fixing portion (20) fixed to the cover plate along a peripheral portion of said front surface of the cover plate (top surface of 19 in FIG. 2), and wherein said closing member includes an annular contact portion (26) integrally formed with said two fixing portions of flexible and resilient material (column 2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation), and extending in a direction along, and essentially in parallel to, said front surface of the cover plate (column 2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation); wherein said annular contact portion includes an end defining a through opening (FIG. 1) and having at least one protrusion (22) extending from said end and configured to engage an outer surface of a container (FIG. 2), and wherein said annular contact

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portion of the container cover is adaptable to turn inside out to tightly grasp or cling onto a side surface of the container by elastic force of the flexible and resilient annular contact portion without said at least one protrusion of the annular contact portion engaging with a shoulder or flange of the container for catch (FIGS. 1-2; column 3 lines 40-50); wherein the cover plate has a round formed at a side end of the cover plate along its lower peripheral portion (portion of 19 adjacent 23 in FIGS. 2); wherein the round of the cover plate is shaped to engage with an upper inner surface in the opening of the container for covering, and the round of the cover plate is covered with said first fixing portion of the closing member such that the round area of the cover plate, covered with the flexible and resilient first fixing portion, provides a resiliently sealed contact against the upper inner surface in the opening of the container (FIGS. 1-2; column 3 lines 40-50).

### ***Response to Arguments***

**5. Applicant's arguments, see amendment filed 07/29/2011, with respect to the rejection of Claims 3, 5, 9, 12, 14, and 15 under 35 USC §112 have been fully considered and are persuasive in view of the amendment.**

The original rejection under §112 has been withdrawn.

**6. Applicant's arguments, see amendment filed 07/29/2011, with respect to the rejection of Claims 3 and 5 under 35 USC §102(b) as being anticipated by McMann (US Pat. No. 1,857,853), have been fully considered, but are not persuasive.**

In response to Applicant's argument that "McMann does not teach a container cover wherein the annular contact portion can have a protrusion that independently

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engages an outer surface of a container to be covered” (emphasis original), the Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The courts have held an apparatus’s claims covers what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitation of the claims. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-.2 (Fed. Cir. 1997); *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); *Ex parte Masham*, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987). Furthermore, it has been held that a recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138). While the examiner appreciates Applicant’s opinion regarding the new limitations, the Examiner is not convinced that the manner in which substantially all the limitations of the claim(s) are intended to be employed differentiates the claimed apparatus from the prior art.

In response to Applicant’s argument that “McMann does not teach a container cover wherein the annular contact portion can have a protrusion that independently engages an outer surface of a container to be covered” (emphasis original), the

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Applicant is reminded that the Examiner must give the claims their broadest reasonable interpretation. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The term "independent" is defined as "not dependent; not depending or contingent upon something else for existence, operation" (independent. *Dictionary.com Unabridged*. Random House, Inc. <http://dictionary.reference.com/browse/independent>); therefore, because McMann's feature 22 engages the outer surface of the container 16 without being contingent upon any other feature engaging 16, it can be interpreted to "independently engage" such surface. Furthermore, the McMann language cited by the Applicant does not impede the reference from anticipating this broad definition. Instead the Examiner has applied an overly limiting interpretation to the term.

In response to Applicant's argument that "McMann relies on an interaction between the protrusion and an undercut or shoulder of the container in order to be attached to the container....[therefore] McMann's cover can only engage a container for which it was specially made," the Examiner points out that the logic of this argument relies on the unsubstantiated premise or assumption that any such interaction must mean the cover can only engage a container which is specially made. There is no evidence or support in the McMann reference to substantiate this premise.

Furthermore, as now noted in the prior art rejection *supra*, McMann states "[t]he elasticity or compressibility of the flange permits of its compensating for any inequalities in...the container" (column 3 lines 40-50) sufficiently anticipates that the cover is capable of fitting differently sized and shaped containers.

In response to Applicant's argument that the McMann fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "capable of engaging a container irrespective of the size and shape of the container") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that McMann includes additional structure not required by Applicant's invention, it must be noted that McMann discloses the invention as claimed. The claims in the instant application are written using the transitional phrases "comprising" and "consisting essentially of". The fact that it discloses additional structure not claimed by the Applicant is irrelevant since it does not materially affect the basic and novel characteristics of the claimed invention. See MPEP § 2111.03.

7. For these reasons, the rejection of Claims 3 and 5 under 35 USC §102(b) as being anticipated by McMann (US Pat. No. 1,857,853), is respectfully maintained.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NED WALKER whose telephone number is (571)270-3545. The examiner can be reached on Monday - Friday 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Pickett can be reached on 571-272-4560. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/  
Supervisory Patent Examiner, Art Unit 3788

/Ned Walker/